

REMARKS

Reconsideration of the objection and the rejections set forth in the Office Action dated April 12, 2005, is respectfully requested. The Examiner rejected claims 1-82. Applicants have cancelled claims 1-82 without prejudice and have added new claims 83-110. Accordingly, claims 83-110 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. Replacement Drawing Sheets

Applicant notes with appreciation the Examiner's indication in the Office Action that the replacement drawing sheets filed on July 23, 2004, were deemed acceptable.

B. Jones Does Not Disclose or Suggest the Creation or Use of a Source File into which Information Pertaining to Ownership of Intellectual Property Rights has been Embedded as Recited in New Claims 83-110.

In the Office Action, the Examiner rejected claims 1-6, 12-20, 37-39, 42-47, 50, 52-55, 57-73, 75, 81, and 82 under 35 U.S.C. § 102(b) as allegedly being anticipated by Jones, International Publication No. WO 95/15522 and asserted that claims 7-11, 21-36, 40, 41, 48, 48, 51, 56, 74, and 76-80 under 35 U.S.C. § 103(a) are rendered obvious by Jones in view of Chow et al., United States Patent No. 6,292,092, and/or Hull et al., United States Patent No. 5,465,353. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claims 83 and 94, neither Jones, Chow et al., nor Hull et al. anticipates or renders obvious new claims 83 and 94. Therefore, it is submitted that claims 83 and 96, as well as claims 84-95 and 97-110 that depend thereon, are in condition for allowance.

In contrast to the system and method recited in new claims 83-110, Jones does not disclose or suggest "embedding information pertaining to ownership of intellectual property rights into a source file." As recognized by the Examiner, Jones teaches that, in order to verifying an author of a file, "[t]he author of the file must identify himself before the file is fingerprinted" and that "[t]he central computer keeps a record of the

author along with the fingerprint and date and time stamp of the file." See Jones at p. 3, II. 9-13.

Applicant however respectfully disagrees with the Examiner's conclusion that the above passage is sufficient to disclose branding a source file with indicia of ownership. A mere statement that the author identifies himself before the file is fingerprinted does not necessarily teach that the source file has been branded with indicia of ownership, particularly when the very next sentence teaches against embedding the indicia by requiring that "[t]he **central computer** keeps a record of the author along with the **fingerprint** and date and time stamp of the file." See id. (emphasis added). Rather than teaching that the author information is embedded in the source file, Jones instead discloses that the central computer keeps the record of the author external to the source file.

Turning to branding source files with respect to intellectual property rights, the Examiner noted that claims 1-82 do not recite such a limitation. The Examiner did not attempt to further extend his reading of Jones to include ownership of intellectual property rights in the source file and thereby recognized that the above passage is not sufficient to disclose that the source file can be branded with indicia of ownership of intellectual property rights in the source file. Jones, in fact, discloses no such feature. Thus, Applicant's new independent claims 83 and 94 each recite "embedding information pertaining to ownership of intellectual property rights into a source file."

At least one recited element of new claims 83 and 94 therefore is totally missing from Jones. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate

patentability, must also be clear and unambiguous. Further, “[t]he identical invention must be shown in as complete detail as contained in the...claim.” *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, since Jones fails to disclose each and every element of independent claims 83 and 94, claims 83-110 are not anticipated. Applicant therefore submits that claims 83-110 are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of Jones in a Manner that Precludes the Patentability of New Claims 5-9 Under 35 U.S.C. § 103.

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met.” (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), *citing, B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

In the manner discussed in more detail above, at least one recited element of claims 83-110 is totally missing from Jones. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify Jones in a manner that

renders claims 83-110 obvious. First, the Examiner has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited reference. According, it is submitted that Jones does not render claims 83-110 obvious. Applicant therefore asserts that claims 83-110 are in condition for allowance.

For at least the reasons set forth above, it is submitted that new claims 83-110 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (650) 614-7660 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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